



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/854,648	05/14/2001	Amy J. Donnan	DON0002/US/2	8779

7590

07/24/2002

Kagan Binder, PLLC
Maple Island Building
Suite 200
221 Main Street North
Stillwater, MN 55082

EXAMINER

SUHOL, DMITRY

ART UNIT

PAPER NUMBER

3712

DATE/MAILED: 07/24/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/854,648

Applicant(s)

DONNAN, AMY J.

Examiner

Dmitry Suhol

Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-16 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the structural features encompassed by the phrase "linguistically" can't be determined.

Regarding claim 3, the phrase "such as" renders the claim indefinite since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. *Ex parte Steigewald*, 131 USPQ 74.

Regarding claim 6, the structural features encompassed by the phrase "tear drop-shaped" can't be determined, rendering the claim indefinite.

Regarding claim 7, the structural features encompassed by the phrase "sun-shaped" can't be determined.

Regarding claim 8, the structural features encompassed by the phrase "fire-shaped" can't be determined, rendering the claim indefinite. There is no antecedent basis for "the playpiece generally symbolic of anger".

Regarding claim 9, the structural features encompassed by the phrase “ghost-shaped” can’t be determined, rendering the claim indefinite. There is no antecedent basis for “the playpiece generally symbolic of fear”.

Regarding claim 12, the structural features encompassed by the phrase “plush, pillow bag” can’t be determined, rendering the claim indefinite.

In view of the examples above, the applicant is required to carefully review all of the claims in order to correct those having the same defects but not specifically pointed to.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 12-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Shaver. Shaver discloses an interactive toy containing all the elements of the claims including, a plurality of play pieces as required by claim 1 (figs. 9a-9j, 10a-10g, 11a-11j, and 12a-12j) where it is considered that since an individual can discuss a particular emotion then the play pieces are construed to be linguistically symbolic of a particular emotion, a container comprising a storage chamber as required by claim 1 (fig. 1), each play piece comprising one or more unique indicia as required by claim 2 (figs. 9a-9j,

10a-10g, 11a-11j, and 12a-12j), unique linguistic indicia as required by claim 3 (figs. 9a-9j, 10a-10g, 11a-11j, and 12a-12j), a first play piece corresponding to love, a second play piece corresponding to sad, a third play piece corresponding to happiness, a fourth play piece corresponding to mad, and a fifth play piece corresponding to being scared as required by claim 4 (figs. 10a-10g) and the container being a plush, pillow bag as required by claim 12 (col. 3, lines 36-43). Shaver further discloses a method for exploring emotional experience including providing a toy and interacting with the toy as required by claims 13 and 14 (col. 4, lines 25-29), it is inherent that the play piece would be withdrawn from the container as required by claim 15, and naming the emotion corresponding to a play piece as required by claim 16 (col. 5, lines 14-41).

Claims 1, 4 and 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Frampton. Frampton discloses an interactive toy containing all the elements of the claims including, a plurality of play pieces as required by claim 1 (fig. 1, elements 61), a container comprising a storage chamber as required by claim 1 (fig. 1, element 64), a first play piece generally symbolic of love, a second play piece generally symbolic of sad, a third play piece generally symbolic of happiness, a fourth play piece generally symbolic of mad, and a fifth play piece generally symbolic of being scared as required by claim 4 (fig. 5), a sad play piece being a tear drop shape as required by claim 6 shown in figure 5, the element in the lower left hand corner, a happy play piece being a sun shape as required by claim 7 is shown in figure 5, element 72, a mad play piece being a fire shape as required by claim 8 (fig. 5, element 75) and a scared play piece

being in a ghost shape as required by claim 9 (fig. 5, element in the lower right hand corner).

Claims 1 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Fredericks. Fredericks discloses an interactive toy containing all the elements of the claims including, a plurality of play pieces as required by claim 1 (fig. 1, elements 50 and 54), a container comprising a storage chamber as required by claim 1 (fig. 1, element 10) and the play pieces comprising one or more panels enclosing a stuffing material (col. 3, lines 11-19).

Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Aduvala. Aduvala discloses an interactive toy that symbolically represents emotions through visual and linguistic means containing all the elements of the claims including a plurality of play pieces where each play piece is generally symbolic of a particular emotion both visually and linguistically as required by claim 1 (figs. 4a-4h), a container comprising a storage chamber into which play pieces may be independently stored or withdrawn as required by claim 1 (fig. 1, element 18), and unique linguistic indicia as required by claim 3 (figs. 4a-4h).

Since the above references include all of the structural elements of the claims they are presumed to be inherently capable of all of the claimed functions.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaver. Although shaver discloses most the elements of the claims as stated above including the second, third, fourth and fifth play pieces comprising a respective unique color scheme as required by claim 5 (col.4, lines 58-59). The reference fails to mention the first play piece comprising a color scheme that includes a combination of the color schemes of the second, third, fourth and fifth play pieces as required by claim 5, and the container being heart shaped as required by claim 11. However, it would have been obvious, to one having ordinary skill in the art, at the time of the claimed invention to manufacture the device of Shaver with a first play piece comprising a color scheme that includes a combination of a color scheme of the second, third, fourth and fifth play pieces and a heart shaped container for the purpose of interest to the child. The color schemes and the shape of the container are an obvious choice of design in as much as the applicant discloses no advantage or critical need for them.

Response to Arguments

Applicant's arguments filed 28 June 2002 have been fully considered but they are not persuasive. Applicant's argue that shapes encompassed in claims 6-10 are

Art Unit: 3712

sufficiently definite, the examiner respectfully disagrees. A tear drop shape could be a variety of shapes such as a circle, oval, or blob with no clear defined boundaries, a sun shape can be a variety of shapes as well such as a circle, an oval, a half circle among others, as to a fire shape the examiner can't even begin to describe the variety of shapes that are encompassed by such a term.

Applicant's further argue that Shaver does not teach an interactive toy that symbolically represents emotions through visual and linguistic means nor is used to represent emotions kinesthetically, examiner once again respectfully disagrees. Shaver teaches a toy containing a variety of playpieces being generally symbolic of a particular emotion, the play pieces have indicia on them that clearly show different emotions and as applicant's point out there is always a discussion that takes place with regards as to what each playpiece means to a particular child, which clearly fills a linguistic means limitation. As to the limitation of a toy being used to represent emotions kinesthetically, Shaver clearly teaches in col. 4, lines 47-57, that a child selects a playpiece based on his/her feelings on an experience and then places the playpiece into the slot of the teddy bear.

With respect to the arguments regarding the Frampton and Fredericks reference, it is considered that the applicants arguments are based on functional limitations, and since Frampton clearly discloses the structure of the claims it is presumed that the Frampton device is inherently capable of all of the claimed functions.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 703-305-0085. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Application/Control Number: 09/854,648
Art Unit: 3712

Page 9

ds
July 22, 2002

A handwritten signature in black ink, appearing to read 'D.H.B.', with a horizontal line underneath.

DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700